

### **REMARKS**

Upon entry of the present amendment, the claims in the application are claims 25-29.

#### ***Claim Rejections - 35 USC 112***

The present amendment complies with or overcomes the objection to claim 27.

Claims 27, 28 and 29 are identical to Canadian claims 1, 2 and 3 of the corresponding Canadian Patent 2,381,217 (granted April 27, 2010), a copy of which was submitted with Amendment-L filed May 15, 2010, with the exception of amending “surrounded by” to read “adjacent to” in claim 27.

#### ***Claim Rejections - 35 USC 112***

Applicant traverses the 103 rejections.

Claim 26 requires a flat elastic base member. The OA says Choi discloses an elastic base member 15. However, Choi does not disclose that tapping plate 15 is flat, nor elastic.

Claim 26 also requires that each needle comprises a core, a sharpened portion, and a thickened portion, and said thickened portions are fixed in said flat elastic base member in such a way that the sharpened portions protrude from the flat elastic base member.

The OA says Choi discloses each of the needles comprising a rod member (core), a sharpened portion and a head (the portion of the needle adjacent to base member 15).

However, Choi does not disclose that each needle 11, 12, 13A, 13B, and 14 comprises a core, a sharpened portion, and a thickened portion, nor that said thickened portions

are fixed in said flat elastic base member in such a way that the sharpened portions protrude from the flat elastic base member.

In particular, Choi does not disclose that magnetic “needle” and magnet 11 comprises a core, a sharpened portion, and a thickened portion, nor that it has a thickened portion fixed in a flat elastic base member in such a way that a sharpened portion protrudes from a flat elastic base member. See Choi Figs. 2A and 2B.

Further, Choi does not disclose that needle 12 comprises a core, a sharpened portion, and a thickened portion, nor that it has a thickened portion fixed in a flat elastic base member in such a way that a sharpened portion protrudes from a flat elastic base member. See Choi Figs. 2A and 2B.

Also, Choi does not disclose that needle 13A comprises a core, a sharpened portion, and a thickened portion, nor that it has a thickened portion fixed in a flat elastic base member in such a way that a sharpened portion protrudes from a flat elastic base member. See Choi Figs. 2A and 2B.

Moreover, Choi does not disclose that needle 13B comprises a core, a sharpened portion, and a thickened portion, nor that it has a thickened portion fixed in a flat elastic base member in such a way that a sharpened portion protrudes from a flat elastic base member. See Choi Figs. 2A and 2B. Note that Choi Fig. 2A shows that the **thickened portion** of needle 13B protrudes from the non-flat, non-elastic tapping plate 15.

Additionally, Choi does not disclose that needle 14 comprises a core, a sharpened portion, and a thickened portion, nor that it has a thickened portion fixed in a flat elastic base member in such a way that a sharpened portion protrudes from a flat elastic base member. See Choi Figs. 2A and 2B. Note that Choi Figs. does not show that needle 14 has a core, a

sharpened portion, nor a thickened portion, nor that any thickened portion is fixed in a flat elastic base member in such a way that any sharpened portion protrudes from a flat elastic base member.

The OA says Choi discloses the various needles in the same treatment device can be different materials (see column 5, lines 28-32).

However, in contrast, Choi does not disclose:

“one or more groups of said needles have a partially coated core;

one or more groups of said needles have multilayer coatings of said core and sharpened portion;

one or more groups of said needles differ from the other groups by the materials they are produced of or by the coating materials, which have different electrochemical potentials;

said needles and their coatings are fabricated from materials selected from a group comprising steel, copper, chromium, nickel, silver, cobalt, aluminum, magnesium, zinc, tin, titanium, vanadium, beryllium, gold, platinum, strontium, tellurium or their alloys and oxides; and

each of said needles is placed on the base member in such way that adjacent needles are made from materials and/or their alloys with different electrochemical potentials and are designed for contacting an user's skin.”,

as required by claim 26.

The OA does concede that Choi does not disclose the needles as being partially coated with a coating.

The OA alleges that Gabrusenok teaches that acupuncture needles should be **partially** coated with coatings of a material which is different than the needle material in order to obtain the advantage of creating electrochemical potentials (see abstract of Gabrusenok).  
Emphasis added.

However, Gabrusenok does not say what the OA says

In contrast, Gabrusenok merely says “ACCUPUNCTURE NEEDLE, containing cylindrical rod with sharpened end made of heterogeneous metals, having a distinguished feature that heterogeneous metal arranged on a needle in layers, concentrically.” See Gabrusenok abstract.

Gabrusenok also says nothing about “one or more **groups of said needles** have a **partially** coated core”, as required by claim 26. Emphasis added.

Also, Gabrusenok columns 1 and 2 uses the term “coated”, with no teaching of “partially coated”.

The OA also concedes that the combination of Choi and Gabrusenok fails to disclose the needles having enlarged head portions lying in a single plane and a flat resilient base member.

It is respectfully submitted that the combination of all three cited references fails to teach or make obvious the following features (which the OA fails to even mention):

“one or more **groups** of said needles have a **partially coated core**;

one or more **groups** of said needles have **multilayer coatings of said core and sharpened portion**;

one or more groups of said needles differ from the other groups by the materials they are produced of or by the coating materials, which have different electrochemical potentials;

said needles and their coatings are fabricated from materials selected from a group comprising steel, copper, chromium, nickel, silver, cobalt, aluminum, magnesium, zinc, tin, titanium, vanadium, beryllium, gold, platinum, strontium, tellurium or their alloys and oxides; and

each of said needles is placed on the base member in such a way that adjacent needles are made from materials and/or their alloys with different electrochemical potentials and are designed for contacting an user's skin" (as required by claim 26, emphasis added);

nor

"at least a portion of said needles being made with solid and/or partial coats; and in the case of partial coat of said needle, the areas adjoining to their sharpened portions are made of at least \*two\* materials which have different electrochemical potentials" (as required by dependent claim 27, emphasis added);

nor

"said head portion being wider than said rod member;

....

said needles including one or more first needles made from and/or coated with a first material, and one or more second needles made from and/or coated with a second material;

one or more \*third\* needles made from and/or coated with a third material having a different electrochemical potential than that of said first and second materials;

the coating on at least one of said needles comprises a multilayer coating of different materials;

the material in said needles and/or coatings being selected from steel, copper, chromium, nickel, silver, cobalt, aluminum, magnesium, zinc, tin, titanium, vanadium, beryllium, gold, platinum, palladium, strontium and tellurium or alloys or oxides thereof;

said first and second materials having different electrochemical potentials;

each said needle being adjacent to needles having \*base materials and coatings\* made from different materials;

said needles being arranged in said base member in a configuration whereby, when adjacent needles having sharp portions are exposed to a surface of contact with a user's epidermis, said sharp portions are either coated with and/or are made from different materials; and

said partially-covered needles expose a surface of contact between each needle and the user's epidermis to at least said \*first and second materials\*" (as required by claim 28, emphasis added);

nor

"said head being wider than said rod;

....

at least a portion of said needles being made with solid and/or partial coatings;  
in the case of partial coating of the rods, areas near the sharp first ends including at least two materials having different electrochemical potentials;

needle rods and coatings being made of material selected from the group consisting of copper, chromium, nickel, silver, cobalt, aluminum, magnesium, zinc, tin, titanium,

vanadium, beryllium, gold, platinum, palladium, strontium and tellurium or alloys or oxides thereof; and

the needles being arranged in the base member in a configuration such that **adjacent** needles comprise **different rod and coating materials**” (as required by claim 29, emphasis added).

Also, there is no teaching or motivation in the cited references to modify or combine the references in an attempt to achieve the invention recited in the new claims.

In contrast, the mythical PHOSITA would not even attempt to re-engineer the cited art to try to arrive at applicant’s invention specified by the new claims.

Further, modifying or combining the cited art as suggested by the OA would not result in applicant’s invention as specified by the claims.

In a wide-ranging decision rendered in a case that had previously been before the U.S. Court of the Federal Circuit, the Court this time affirmed a jury instruction that **a modification is not obvious unless the prior art suggests** the desirability of the modification. *Cordis Corp. v. Medtronic AVE, Inc. and Boston Scientific Corp*, 85 USPQ2d 1427 (Fed Cir 2008).

If the prior art references as a whole do not teach, suggest or motivate that combination, then **they may not be combined**. The **mere fact that the prior art can be modified** does not make the modification obvious **unless \*the prior art\* suggests the desirability of the modification**.

Furthermore, a **prima facie** case of obviousness is a procedural tool, which, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the OA seeks, but **also** that the prior art **\*compels\*** such a conclusion if

applicant produces no evidence or argument to rebut it. In re Spada, 15 USPQ 2d 1655, 1657 (CAFC 1990).

Applicant respectfully submits that the genius of invention is often a combination of known elements, which in hindsight seems pre-ordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine the cited references. Gambro Lundia AB v. Baxter Healthcare Corp, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

“Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. Section 103(a). This legal construct is akin to the “reasonable person” used as a reference in negligence determinations. The legal construct also presumes that all prior art references **in the field of the invention** are available to this hypothetical skilled artisan. (Emphasis added). See In re Carlson, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed.Cir. 1993).

“As this court has stated, **\*\*\*virtually all [inventions] are combinations of old elements.**” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). **Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would**



be “an illogical and inappropriate process by which to determine patentability.”  
Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed.Cir.  
1996).

The opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied \*rigorously\*. In re Dembiczak, 175 F. 3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); In re Gartside, 203 F.3d 1305, 53 USPQ 2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

Whether a motivation to combine prior art references has been demonstrated is a question of fact. Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000).

It is impermissible for the Examiner to first ascertain factually what applicant did, and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant’s invention from such prior art. In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966).

The test to be applied is whether the claimed invention would have been obvious to one skilled in the art when the invention was made, not to an Examiner after learning all about the invention. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983).

Inventions must be held to be non-obvious where neither any reference, considered in its entirety, \*nor the prior art as a whole\*, suggested the combination claimed. Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985);

ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 932-33 (Fed. Cir. 1984).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success \*must both\* be found \*in the prior art\*, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438.

In light of the foregoing, applicant respectfully requests reconsideration of the obviousness rejection with a view toward withdrawing same, especially in view of the presently amended claims.

**Conclusion**

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not convinced that the application is in condition for allowance, it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an attempt to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

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